Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI HONJO, KATSUTO TANAKA, and HIDEKI YAMAMOTO

Appeal No. 2003-1951
Application No. 09/930,258

ON BRIEF

Before GARRIS, OWENS, and TIMM, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1, 4, 5, 7, 8, and 10. The only other claims pending in the application, i.e., claims 2, 3, 6, 9, and 11, are not subject to rejection. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

Claims 1, 4, 5, 7, 8, and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,724,187 issued to Varaprasad et al. on March 3, 1998 (Varaprasad).

Appellants indicate that the claims stand or fall together (Brief, p. 3). We select claim 1, the only independent claim, to represent the issues on appeal. Claim 1 reads as follows:

1. A glass plate comprising:

a glass substrate comprising a major surface divided into a central major portion and a peripheral portion surrounding said central major portion; and

an oxide film formed on said central major portion by baking a precursory film, said peripheral portion being free from said oxide film such that said peripheral portion is free from shrinkage force caused by said baking.

We affirm substantially for the reasons advanced by the Examiner in the Answer (pp. 2-5) and add the following primarily for emphasis.

OPINION

The Examiner has established that Varaprasad describes a glass plate having all the structural features required by claim 1, i.e, it has both a glass substrate (2) and an oxide film (7) on the central major portion of the glass substrate (Answer, pp. 2-3; Varaprasad, col. 19, ll. 33-35, Fig. 3B, and col. 29, l. 61 to col. 26). While the claim further specifies that the oxide film be formed by baking a precursory film and that the peripheral portion be free from shrinkage caused

by said baking, we agree with the Examiner that this limitation does not, on its face, indicate a patentable difference between the product of Varasparad and the claimed product (Answer, p. 3).

Appellants' response is two pronged. First Appellants argue that, because an unbaked film cannot teach a baked film, Varaprasad does not teach every limitation of the claimed invention (Brief, p. 4). Second, Appellants argue that there are structural differences between the claimed glass plate and the glass plate of Varaprasad (Brief, pp. 4-5).

The claims are directed to a glass plate *product*. While, as pointed out by Appellants (Brief, p. 3), it is true that "[a] prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently, to anticipate," *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), "it is the patentability of the *product* claimed and *not* of the recited process steps which must be established." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). Moreover, "when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection ... is eminently fair and acceptable." *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). *Brown*, 459 F.2d at 535, 173 USPQ at 688. The burden is then upon the applicants to come forward with evidence establishing that the process difference claimed does, in fact, result in an patentable difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983).

The Examiner has established that Varaspasad describes a glass plate with an oxide film on the central portion of a glass substrate. That is the same configuration as claimed. Moreover, the indication in Varasparad that the oxide film can be deposited by a variety of film deposition means including, but not limited to, such methods as vacuum deposition techniques, thermal spraying, pyrolytic deposition, chemical vapor deposition, wet chemical deposition, and thick film methods (col. 19, ll. 40-57) is evidence that the chemical structure and nature of the film is the same notwithstanding the deposition technique used. The Examiner has met the initial burden for establishing a *prima facie* case.

Appellants make several arguments with regard to structural differences. But we are not persuaded that Appellants have met their burden in rebuttal.

Appellants first argue that "[t]he limitation 'said peripheral portion being free from said oxide film such that said peripheral portion is free from shrinkage force caused by said baking' directly claims a structural difference in the final product." (Brief, p. 4). The shrinkage force in the peripheral portion claimed is discussed by Appellants as being due to shrinkage of the oxide film in that location during baking (specification, p. 2, ll. 8-11) and, according to Appellants, it is the absence of the oxide film in that location that solves the problem. But, just as in the claimed product, oxide film is not present on the peripheral portion of the glass substrate (2) of Varaprasad. It is, thus, reasonable to conclude that the peripheral portion of Varaprasad is free of shrinkage force as claimed.

Appellants also argue that there are both material and structural differences between an unbaked oxide film as disclosed by Varaprasad and a baked film (Brief, p. 4). But Appellants have not shown such a difference, in fact, exists. In this regard we note again that Varaprasad mentions a number of methods for depositing the oxide film including vacuum deposition techniques, thermal spraying, pyrolytic deposition, chemical vapor deposition, wet chemical deposition, and thick film methods (col. 19, ll. 40-57). While Appellants rely upon Examples 1-3 in Table 1 on page 12 of the specification as showing a difference in photocatalytic capability between baked and unbaked films, none of those examples compare films made by baking a precursor with films made by the other techniques mentioned in Varasparad. Moreover, as acknowledged by Appellants in the Reply Brief (p. 1), all of the examples, including Comparative Example 1, bake precursors to form oxide film. The examples Appellants rely upon, thus, do not show a difference in photocatalytic capability between baked and unbaked films as alleged. The comparative difference between the examples is the extent of the film to the peripheral edges of the glass, not baking. Varaprasad, like Appellants' Examples 1-3, does not have oxide film on the periphery of the glass substrate. The "difference" illustrated in the examples does not exist between Varasparad and the claimed glass plate. The evidence, therefore, is not probative for the proposition that there is a patentable difference between the glass plate of Varaprasad and the claimed glass plate.

We conclude that the Examiner has established a *prima facie* case of anticipation with respect to the subject matter of claims 1, 4, 5, 7, 8, and 10 which has not been sufficiently rebutted by Appellants.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1, 4, 5, 7, 8, and 10 under 35 U.S.C. § 102(b) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

BRADLEY R. GARRIS Administrative Patent Judge	)
TERRY J. OWENS Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
CATHERINE TIMM Administrative Patent Judge	)

CT/jg

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